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Sughrue Mion Zinn MacPeak & Seas PLLC
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EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,560

Applicant(s)

FORTE, PATRICK A.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments to the claims has effectively addressed and resolved the 35 U.S.C. 112, second paragraph objection.
2. Applicant's arguments filed 10/30/03 have been fully considered but they are not persuasive.
3. The Applicant effectively summarizes the differences between the primary reference Randle and the claims by stating , " Randle does not anticipate the claims since there is no affirmative disclosure of a point of deposit at a commercial institution ... as opposed to a bank." Figures 1B and 3B illustrates an entity other than the consumer's bank as providing services that provide payment needs of its members and its members customers. The electronic commerce trust system (ECTS) provides financial services such as pre-paid accounts to facilitate cash-less transactions. The Applicant proposes that setting up a prepaid account with an entity other than the consumer's bank and using it as if it was the consumer's bank is original and unique even though the Applicant does disclose that for account reconciliation the consumer's bank is the finale action.
4. The Examiner submits that a financial institution is in fact a merchant providing services of its own and providing means to conduct transactions with other merchants be they the consumers bank or other merchants. Maintaining that a merchant, other than a bank, that conducts the normal functions associated with a bank is unique and

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original obfuscate the fact that when a merchant is performing the function associated with and inherent to a bank, it is in fact no different than a bank.

5. As per claim 20, the claim teaches to the Randle reference and does not suggest affirmative disclosure of a point of deposit at a commercial institution ... as opposed to a bank. Claim 30 delineates a customer demand deposit account, a customer stored value account, and a merchant stored value account establishing them as separate and distinct entities. Both the customer stored value account and the merchant stored value account are effectively prepaid accounts that are neither unique nor original. Randle discloses the uses of prepaid accounts and elaborates in his discussion of "cashless" transactions.

6. The Applicant further states "... can move value from existing stored value account into existing customer bank account (with the resulting funds drawn from the merchant account and deposited into the customer account) with the merchant stored-value infrastructure being advised as to the change in the stored-value balances." Neither claim 20 or 30 discloses such a transaction. As per claim 20 and claim 30, both delineates a customer demand deposit account, a customer stored value account, and a merchant stored value account establishing them as separate and distinct entities.

The Applicant argues against the references combined in the 103 section of the Office Action. The Examiner presents that one cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references. *In re Young*, 159 USPQ 725 (CCPA 1968)

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7. Also, a reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969). *The justification for the use of McKeen is presented in the following claim rejection section.*

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Randle et al. U.S. Patent 6,594,647B1 [Randle '647].

As per claim 20:

Randle '647 discloses:

means allowing a customer to access his individual program account, the individual program account being an account representing an array of accounts that have been individually selected by the customer from the totality of the accounts and including at least one stored value account for a merchant; Col. 11, lines 20-65, Col. 12, lines 1-10.

a host processor for executing transaction instructions and maintaining individual program account information, said host processor including a database for maintaining individual program account transactions and records; Col. 4, lines 1-67.

means for establishing and maintaining a plurality of customer individual program accounts; Col. 3, lines 47-55.

means to support of a customers' transactional interchange of individual program account including access to a stored value account having been pre-authorized by a customer to settle transactions. Col. 3, lines 53-67.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randle '647 as applied to claim 1 above, and further in view of McKeen et al. U.S. Patent 6,529,880B1 [McKeen '880]

As per claim 21:

Randle '647 discloses the claimed invention except for a plurality of stored value accounts maintained by a merchant for a plurality of customers each having an individual program account. McKeen '880 teaches that it is known in the art to provide a plurality of stored value accounts maintained by a merchant for a plurality of customers each having an individual program account.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the real time bank-centric universal payment system of Randle '647 with the plurality of stored value accounts maintained by a merchant for a plurality of customers of McKeen '880, Col. 7, lines 25-35, in order to simplify and expedite the transaction between the customer and the merchant.

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As per claim 22:

Randle '647 further discloses;

plurality of demand deposit accounts maintained by a plurality customers in a federally insured banks as a component of an individual program account. Col. 9, lines 54-60.

As per claim 23:

Randle '647 further discloses;

means to support, at a merchant locations, a plurality of point of sale terminals by which a customer may convert the value of a negotiable instrument to a customer's stored value account. Col. 7, lines 28-45.

As per claim 24:

Randle '647 further discloses;

means to support an array of mechanisms by which customers may convert value from one account in their individual program account to another account in the same individual program account. Col. 5, lines 35-67.

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As per claim 25:

Randle '647 further discloses;

means enabling said merchant to utilize point of sale terminals to access services to verify a check presented by a customer to the merchant. Col. 10, lines 44-67.

As per claim 26:

Randle '647 further discloses;

means for establishing a merchant demand deposit account and providing said merchant access to that same merchant demand deposit account. Col. 7, lines 10-26.

As per claim 27:

Randle '647 further discloses;

means enabling said merchant to credit to a customer's stored value account by an amount based on the value of a negotiable instrument presented to the merchant by the customer. Col. 9, lines 17-50.

As per claim 28:

Randle '647 further discloses;

means enabling a customer to access their stored value account to credit or debit other accounts in their individual program account. Col. 11, lines 20-30.

As per claim 29:

Randle '647 further discloses;

means enabling a customer to utilize the value in the customer's stored value account and instruct the merchant to credit the customer's demand deposit account at a bank with funds from said merchant's demand deposit account. Col. 7, lines 65-67, Col. 8, lines 1-19.

As per claim 30:

Randle '647 discloses the claimed invention, as discussed above, except for the designation of the various accounts unique to the Applicants own terms designation. i.e. individual program account, and stored value account, . PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention " as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., "stored value account".

It would have been an obvious matter of design choice to modify the teachings of "Randle '647.", to substitute the Applicant's terminology for other terms conveying the same meaning, i.e. SVA-prepaid, IPA-customer account, PA-account. Since the applicant has not disclosed that designating the various accounts by his designation, solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does

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not distinguish the invention over similar features in the prior art since, the teachings of Randle '647 will perform the invention as claimed by the applicant with any means, method, or product to establishing a customer individual program account which includes at least one customer stored value account, establishing a customer demand deposit account, establishing a merchant stored value account, and executing a transaction between said consumer and said merchant affecting the account balances in said customer stored value account, said customer demand deposit account and said merchant's stored value account. Col. 4-6, lines 1-67.

As per claim 31:

Randle '647 further discloses;

the step of pre-approving withdrawals from either a customer stored value account or a customer demand deposit account. Col. 7, lines 10-26.

As per claim 32:

Randle '647 further discloses;

the step of establishing accounts within said individual program account. Col. 7, lines 10-26.

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As per claim 33:

Randle '647 further discloses;

step of executing a transaction comprising the step of presenting a negotiable instrument at a point of sale at said merchant, to credit or debit account balances.

Col. 11, lines 30-45.

As per claim 34:

Randle '647 further discloses;

the step of providing customer access to the customer demand deposit account and said customer individual program account accounts to convert balances from one account to another account. Col. 11, lines 30-45.

As per claim 35:

Randle '647 further discloses;

the step of providing merchant access to the merchant stored value account to convert a balance to said customer demand deposit account. Col. 11, lines 30-60.

As per claim 36:

Randle '647 further discloses;

the step of establishing a merchant demand deposit account. Col. 11, lines 30-67.

As per claim 37:

Randle '647 further discloses;

the step of converting a balance from said merchant demand deposit account to said customer demand deposit account. Col. 11, lines 30-67.

As per claim 38:

Randle '647 further discloses;

the steps of said customer presenting a negotiable instrument at a point of sale at said merchant, acceptance of the negotiable instrument by the merchant, crediting a corresponding value corresponding to the negotiable instrument to the customer SVA and paying for the purchase of goods from said merchant. Col. 10, lines 44-67, Col. 11, lines 1-30.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

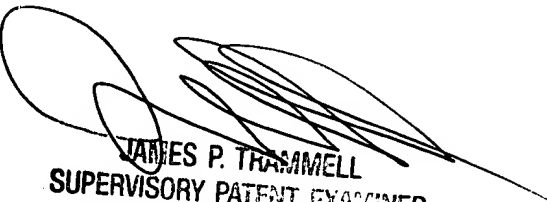
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DLG
November 26, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3000